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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/632,774	08/04/2000	Stacy Haisuka	72189/9813B	2126

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EXAMINER
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MYHRE, JAMES W

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/632,774

Applicant(s)

HAITSUKA ET AL.

Examiner

James W Myhre

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 December 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 22, 2004 has been entered.

### ***Response to Amendment***

2. The amendment filed on December 22, 2004 is sufficient to overcome the previous rejection in view of the Angles et al. (5,933,811) and Filepp et al. (5,347,632) references. The amendment amended Claims 1, 7, 15, and 21 and also indicated Claim 11 was amended; however, no changes were indicated within the claim. The Applicant must correct the status indicator of Claim 11 or make the appropriate amendment to the claim in the next response. The currently pending claims considered below are Claims 1-25.

### ***Double Patenting***

3. Claim 8 is still objected to under 37 CFR 1.75 as being a substantial duplicate of claim 1. When two claims in an application are duplicates or else are so close in

Art Unit: 3622

content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim 1 is an independent method claim which includes seven limitations (a-g). Claim 7 is another independent method claim which includes the first five limitations of Claim 1 (a-e). Claim 8 is dependent upon Claim 7 and adds the final two limitations (f & g) from Claim 1. Therefore, Claim 1 and 8 contain the same seven limitations.

The Applicant indicates that Claim 1 recites two resource locators and Claim 7 recites a single resource locator. However, the Examiner notes that the two resource locators recited in Claim 1 are "a resource locator associated with a sponsorship label" and "a resource locator associated with a click-through of the sponsorship label". Claim 7 also recites two resource locators, which are "a resource locator associated with a sponsorship label" and "a hypertext link associated with a resource locator to be accessed if a user clicks on the sponsorship label" (i.e. "a resource locator associated with a click-through of the sponsorship label"). Therefore, the Applicant's arguments are non-persuasive and the above objection stands.

### ***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 3622

4. Claim 11-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Angles et al (5,933,811).

Claims 11 and 12: Angles discloses a method for displaying advertisements to a user of an online client device, comprising:

a. Connecting to an online server (col 7, lines 53-60 and col 19, line 17 - col 20, line 26);

b. Transmitting and displaying sponsorship label and click-through resource link (col 7, lines 53-60 and col 19, line 17 - col 20, line 26);

c. Retrieving and displaying a first advertisement from the memory of the local online client device (col 11, lines 50-65);

d. Receiving and displaying a second advertisement from the online server (col 7, line 61 – col 8, line 7).

e. Monitoring the user's interaction with the client window to generate a usage history of the user (col 16, lines 26-37); and

f. Selecting the second advertisement from the remote online server based on the usage history of the user (col 15, lines 25-31).

Claim 13: Angles discloses a method for displaying advertisements to a user of an online client device as in Claim 11 above, and further discloses the client device establishing a communication link via a public switched telephone network (col 9, lines 3-44).

Claim 14: Angles discloses a method for displaying advertisements to a user of an online client device as in Claim 11 above, and further discloses the client device requesting and receiving authorization to access the online server (i.e. user logs on)(col 10, line 60 – col 11, line 4 and col 14, lines 9-50).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-5, 7-10, 15-19, and 21-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Angles et al (5,933,811) in view of Petrecca et al (5,781,894) .

Claims 1, 7, 8, 15, and 21: : Angles discloses a system and method for displaying advertisements to a user of an online client device, comprising:

a. Connecting to an online server (col 7, lines 53-60 and col 19, line 17 - col 20, line 26);

b. Transmitting and displaying sponsorship label and click-through resource link (col 7, lines 53-60 and col 19, line 17 - col 20, line 26);

c. Retrieving and displaying a first advertisement from the memory of the local online client device (col 11, lines 50-65);

d. Receiving and displaying a second advertisement from the online server (col 7, line 61 – col 8, line 7).

Art Unit: 3622

e. Monitoring the user's interaction with the client window to generate a usage history of the user (col 16, lines 26-37); and

f. Selecting the second advertisement from the remote online server based on the usage history of the user (col 15, lines 25-31).

However, Angles does not explicitly disclose that the advertisement is being displayed in a window independent of the browser window by a client application operating independently of the browser. However, Petrecca discloses a similar system and method for displaying advertisements to a online user in which a separate, independent client application runs in the background and selects an advertisement to display to the user in a window separate and independent from the browser window (main program)(col 2, line 60 – col 3, line 3). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize such a background program to select and display the advertisement in Angles and to display it in a window which was not part of the window of the main program, such as a browser program (e.g. as a screen saver discussed by Petrecca). One would have been motivated to display the advertisement separately from the browser window in order to allow the advertisers to reach users who may be using any of the various browsers available. i.e. the advertisements would not be tied to any one specific type of browser.

Claims 2, 9, 16, and 24: Angles and Petrecca disclose a system and method for displaying advertisements to a user of an online client device as in Claims 1, 7, 15, and

21 above, and Angles further discloses the client device establishing a communication link via a public switched telephone network (col 9, lines 3-44).

Claims 3, 10, and 17: Angles and Petrecca disclose a system and method for displaying advertisements to a user of an online client device as in Claims 1, 7, and 15 above, and Angles further discloses the client device requesting and receiving authorization to access the online server (i.e. user logs on)(col 10, line 60 – col 11, line 4 and col 14, lines 9-50).

Claims 4 and 18: Angles and Petrecca disclose a system and method for displaying advertisements to a user of an online client device as in Claims 1 and 15 above, and further Angles discloses the click-through link comprises a uniform resource locator (URL) associated with an Internet webpage (col 6, lines 32-58, col 7, lines 19-42, and col 15, lines 43-55).

Claims 5 and 19: Angles and Petrecca disclose a system and method for displaying advertisements to a user of an online client device as in Claims 1 and 15 above, but do not explicitly disclose that the sponsorship label is located on a title bar of the client window. The Examiner notes, however, that Angles presents extensive discussions on how web pages are programmed using the HTML internet protocol language. A standard HTML document defines the location, size, and format where each object file is to be displayed on the web page in accordance with the desires of the



Art Unit: 3622

designer of the web page. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the sponsorship label at the beginning or top of the web page using a title bar or banner format. One would have been motivated to place the sponsorship label in Angles at the top of the page as a title bar in order to draw the user's attention to this important information.

Claims 22 and 23: Angles and Petrecca disclose a method for displaying advertisements to a user of an online client device as in Claim 21 above, and Angles further discloses the user performing a click-through on the link which causes the remote resource (i.e. website) to be downloaded and displayed to the user. However, Angles does not explicitly disclose that this activity would cause the exit window to be removed. The Examiner notes that since the newly downloaded webpage is being displayed it is inherent that the previous page (exit window) would be removed from the display screen. The Examiner also notes that it is common to display an exit button, normally on the browser's action line, which the user may select to exit from the current window. Clicking on such a button usually takes the user back to a default website or webpage, such as back to the browser's homepage. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide an exit button which leads to an exit page and to delete/remove the exit window when the user clicks on a hyper-link to another webpage such as disclosed by Angles. One would have been motivated to include the exit button and window and to remove the exit window upon selection of a link by the user in order to allow the user better

control over the browsing activity and to clear the window for the display of the selected linked webpage.

Claim 25: Angles and Petrecca disclose a method for displaying advertisements to a user of an online client device as in Claim 21 above, and Angles further discloses the communication channel comprising a constant connection communication channel, such as interactive television networks or two-way cable systems (col 9, lines 3-44).

7. Claims 6 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Angles et al (5,933,811) in view of Petrecca et al (5,781,894) and in further view of Filepp et al (5,347,632).

Claims 6 and 20: Angles and Petrecca disclose a system and method for displaying advertisements to a user of an online client device as in Claims 1 and 15 above, and Angles further discloses displaying a series of advertisements when the user "views a particular electronic page for more than a minute" (col 20, lines 14-17). However, Angles does not explicitly disclose that the additional advertisements are coming from a play list of advertisements specifying the order in which the advertisements are to be displayed. Filepp discloses a similar system and method for displaying advertisements to a user of an online client device in which the downloaded advertisements "may be presented to the user on an individual basis from queues of advertisements". The "Individual queues of advertisements are constructed based upon data collected on the particular applications that were accessed by a user, and upon

events the user generated in response to applications" (col 9, lines 30-38). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the advertisements downloaded in Angles into queues and to present the advertisements in the queue as a series of advertisements. One would have been motivated to use such a queuing system to present the most pertinent advertisement to the user first, then the next most pertinent, etc. in order to select the advertisements best suited to entice selection by the user.

### ***Response to Arguments***

8. Applicant's arguments with respect to claims 1-10 and 15-25 have been considered but are moot in view of the new ground(s) of rejection.

9. Applicant's arguments filed December 22, 2004 in reference to Claims 11-14 have been fully considered but they are not persuasive. The arguments pertain to the newly added limitations in the other independent claims. As noted above, these same limitations have not been added to Claim 11, thus are not persuasive.

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Reilly et al (5,740,549) discloses a system and method for displaying advertisement to online users using a independent program to present the advertisement in a separate window from the main program window.

b. Rakavy et al (5,913,040) discloses a system and method for displaying advertisements in separate windows from the main program window.

c. Schena et al (5,946,646) discloses a system and method for displaying interactive advertisements separately from the main program window.

d. Guyot et al(6,119,098) discloses a system and method for displaying targeted advertisements using a separate client application to generate a separate "advertising window that is continuously displayed on the subscriber's computer ... even if other applications are running concurrently".

e. Gerszberg et al (6,222,520) discloses a system and method for displaying advertisement to an online user in two separate and distinct windows.

f. Hassett et al (6,807,558) discloses a system and method for displaying advertisements utilizing "push" technology to download the advertisements independently from any other activities of the user (e.g. browsing).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The examiner can normally be reached Monday through Thursday from 6:30 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number for Formal or Official faxes to Technology Center 3600 is (703) 872-9306. Draft or Informal faxes, which will not be entered in the application, may be submitted directly to the examiner at (703) 746-5544.

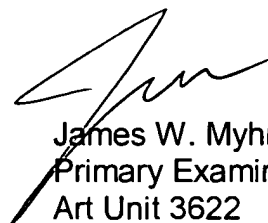
Art Unit: 3622

Note. Effectively April 2005, the examiner's telephone numbers will be changed to (571) 272-6722 (phone) and (571) 273-6772 (Informal faxes), and the examiner's supervisor's telephone will be changed to (571) 272-6724.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-1113.

Handwritten signature of JWM in black ink.

JWM  
January 19, 2005

Handwritten signature of James W. Myhre in black ink.

James W. Myhre  
Primary Examiner  
Art Unit 3622